

PATENT

App. Ser. No.: 09/955,232

Atty. Dkt. No. ROC920010197US1

PS Ref. No.: IBMK10197

REMARKS

This is intended as a full and complete response to the Final Office Action dated February 10, 2006, having a shortened statutory period for response set to expire on May 10, 2006. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-32 are pending in the application. Claims 1-32 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 103

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wakai et al.* (US 2002/0065871, hereinafter *Wakai*) in view of *Kim* (US Patent 6,373,586) and *Rose* (US Patent 5,200,816). Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria, as described below.

With respect to the third criteria, the pending claims recite "intercepting a print file generated by a printer driver from the print request". The Examiner states that *Wakai* describes intercepting a print file generated by a printer driver from the print request at Para. 0239, Lines 3-5. The cited section describes a request which is received by a server and transmitted to a device manager. See Pg. 7, Paras. 00238-0239. The device manager determines may acquire the status of the printer or exercise control of the printer. A request manager may convert the request into a process command and

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transmit the request to a command analysis/process unit. *See id.* Thus, the cited section merely describes a request from a client, a device manager which exercises control of a printer, and a request manager which converts the request into a process command. *See id.* The cited section does not describe intercepting a print file generated by a printer driver from a print request. *See id.* Accordingly, withdrawal of the rejection is respectfully requested.

The pending claims also recite "matching the print file with the stored identification data". The Examiner cites *Wakai* at Para. 0054 and Para. 0068 as describing "matching the print file with the stored identification data". See Pgs. 2-3, Paras. 0054 and 0068. The cited sections describe determining whether a transmission source for object information matches a transmission source that is stored in a transmission source storage unit. *See id.* There is no description in the cited sections of a print file. *See id.* Accordingly, the cited section does not describe matching a print file with stored identification data. Withdrawal of the rejection is respectfully requested.

The pending claims recite "in response to matching the print file with the stored identification data, transforming a print file in accordance with stored print options; whereby the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the printer driver". The Examiner cites to both *Kim* and *Rose* as describing the claimed subject matter. The cited section of *Kim* describes that a printer driver produces a print data file which is then transmitted to a printer. *See Kim*, Col. 4, Lines 46-54. The cited section does not describe matching of the print file with stored identification data nor does the cited section describe transformation of the print file to produce a different output. *See id.* The cited section of *Rose* describes scanning, and not printing. *See Rose*, Col. 26, Lines 1-9. Accordingly, *Rose*, alone or in combination with *Kim*, does not describe transforming a print file generated by a printer driver to produce a printed output different from a printed output that would have been produced by the print file generated by the printer driver. *See id.* Withdrawal of the rejection is respectfully requested.

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With respect to the first criteria of the *prima facie* case of obviousness, the Examiner states that "At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the inventions of *Wakai et al.* and *Kim* and *Rose* because this would create give the user the print the original document or the document as it relates to the stored print options". Thus, the Examiner appears to suggest that the combination would have been obvious because it would give a user the option to print a document using stored print options. First, the Examiner has not cited to any portion of the references which contains such a motivation to combine. Also, in *Kim*, the printer use time between users is adjusted, but the printed output that would have been produced by the print file generated by the printer driver is not changed. See *Kim*, Col. 6, Lines 34-38. This teaches away from the pending claims, in which the transformed print file produces a printed output different from a printed output that would have been produced by the print file generated by the printer driver. See *id.* Accordingly, the prior art teaches away from such a combination, and thus there is no suggestion or motivation to combine the cited references. See MPEP 2143.01.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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